

REMARKS

At the time of the Office Action, Claims 1-20 were pending in the application. In the Office Action, the Examiner rejects Claims 1-20. With this amendment, Applicant amends Claims 1-20 and adds new Claims 21-26. The amendments to the claims are supported by the application as filed and therefore do not add new matter. Accordingly, entry of the amendments and the new claims is respectfully requested.

Applicants have amended the claims to recite particular embodiments that Applicants, in their business judgment, have determined to be commercially desirable at this time. The claim amendments have not been submitted for any reason relating to patentability, such as to overcome any one or more of the Examiner's rejections. Indeed, Applicants believe that the Examiner has not established a *prima facie* showing to support the Examiner's rejections and, as such, Applicants reserve the right to pursue the subject matter of the previously presented, and of the previously or currently cancelled claims in one or more continuing applications.

Claim Rejections - 35 U.S.C. § 112, first paragraph

The Examiner rejects Claims 1-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner states:

The specification fails to teach an optical bar code that comprises sufficient memory for storing a financial prospectus.

The specification fails to teach a magnetic strip that comprises sufficient memory for storing a financial prospectus.

The specification fails to adequately describe an "embedded computer chip" or suitable device for reading an "embedded computer chip."

(Office Action; p. 2). Applicant traverses this rejection and requests reconsideration and allowance of amended Claims 1-20.

With respect to an optical bar code, amended Claim 1 does **not** recite that the optical bar code stores the financial prospectus, as suggested by the Office Action. Instead, amended Claim 1 recites "determining a first **portion** of prospectus data...and encoding the first **portion** of prospectus data as a first optical bar code." (Emphases added). One of ordinary skill in the art is enabled by Applicant's specification to encode a "portion of prospectus data as a first optical bar code" as recited in amended Claim 1.

Similarly, with respect to a magnetic strip, new Claim 21 does not recite that the magnetic strip stores the financial prospectus, as suggested by the Office Action. Instead, new Claim 21 recites “determining a first **portion** of prospectus data...and storing the first **portion** of prospectus data...on a first magnetic strip.” (Emphases added). One of ordinary skill in the art is enabled by Applicant’s specification to store a “portion of prospectus data...on a first magnetic strip” as recited in new Claim 21.

With respect to a chip, new Claim 24 recites “storing the first portion of prospectus data in a first computer chip, wherein the first computer chip is readable by a smart card scanner.” Applicant’s specification describes using a computer chip and a smart card scanner on at least page 4, lines 11-25.¹ Accordingly, one of ordinary skill in the art is enabled by Applicant’s specification to perform the method of new Claim 24.

As shown above, the reasons stated in the Office Action for rejecting the claims under the enablement requirement do not support the rejection of amended Claim 1 and new Claims 21 and 24. In addition, the Office Action fails to apply the proper enablement standard. It is well established that a claimed invention is enabled if a person of ordinary skill in the art “can make and use the invention without undue experimentation.” *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); MPEP § 2164.01. “The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.” MPEP § 2164.01 (citing *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int’l Trade Comm’n 1983), *aff’d. sub nom.*, *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985)). Instead of applying the foregoing standard, the Office Action merely makes the conclusory statement that certain “subject matter was not described in the specification in such a way as to enable one skilled in the art...to make and/or use the invention.” (Office Action; p. 2). The Office Action completely fails to provide any evidence or analysis regarding whether the experimentation needed, if any, would be “undue.” Because the Office Action fails to apply the proper enablement standard, the rejection of the claims is improper. Because Claims 1-26 satisfy the requirements of 35 U.S.C. § 112, first paragraph, Applicant respectfully requests reconsideration and allowance of Claims 1-26.

¹ The foregoing portion of Applicant’s specification, which discusses a computer chip and a smart card scanner, is not intended to limit Claim 24 to a particular embodiment.

Claim Rejections - 35 U.S.C. § 112, second paragraph

The Examiner rejects Claims 1-20 under 35 U.S.C. 112, second paragraph, as being indefinite. In particular, the Examiner states:

In the claims, an embedded computer chip is vague and indefinite.

In the claims, a suitable device for reading an embedded computer chip is indefinite.

(Office Action; p. 2). Applicant traverses this rejection. The claims, as amended, do not comprise the terms “embedded” or “suitable device.” As a result, amended Claims 1-20 and new Claims 21-26 satisfy the requirements of 35 U.S.C. § 112, second paragraph. Applicant therefore respectfully requests reconsideration and allowance of Claims 1-26.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejects Claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Elizabeth Boros, “Multimedia Prospectuses,” Australian Securities & Investments Commission, December 1999 (“*Boros*”) in view of Japanese Publication No. 08142538 A to Ochiai Akiko (“*Akiko*”). Applicant traverses the rejection and respectfully requests reconsideration and allowance of Claims 1-20.

Claims 1, 8, 14, 21, and 24

The cited references fail to support the rejection for several reasons. First, the proposed combination fails to support the rejection because *Akiko* teaches away from amended Claim 1. Second, the cited references fail to teach, suggest, or disclose “encoding the first portion of prospectus data as a first optical bar code...and affixing the first optical bar code to the printed financial prospectus” as recited in amended Claim 1. Third, the cited references fail to teach, suggest, or disclose “storing the first portion of prospectus data in an electronically-readable format on a first magnetic strip...and affixing the first magnetic strip to the printed financial prospectus” as recited in new Claim 21. Fourth, the cited references fail to teach, suggest, or disclose “storing the first portion of prospectus data in a first computer chip, wherein the first computer chip is readable by a smart card scanner...and affixing the first computer chip to the printed financial prospectus” as recited in new Claim 24.

First, the proposed combination fails to support the rejection because *Akiko* teaches away from amended Claim 1. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); MPEP § 2141.02.

Akiko relates to a “bag-shaped page” attached to a book. (Abstract). *Akiko* explains that the “bag-shaped page,” which is “bonded in a releasable manner,” may hold a CD-ROM. (Abstract). The CD-ROM may be removed from the “bag-shaped page” through “an enclosing port” and then the CD-ROM may be placed in a computer or other reading device. (Abstract). Thus, the bag-shaped page in *Akiko* facilitates the removal of the CD-ROM from the book. Accordingly, although the “bag-shaped page” is attached to the book, the CD-ROM is not “affixed” to the book in *Akiko*. Indeed, the intent of *Akiko* is for the CD-ROM to be removed from the book. Because the CD-ROM in *Akiko* is intended to be separated from the book, the CD-ROM may become lost or otherwise disassociated from the book. In contrast, amended Claim 1 recites “affixing the first optical bar code to the printed financial prospectus.” Similarly, new Claim 21 recites “affixing the first magnetic strip to the printed financial prospectus.” By discussing a “bag-shaped page” that facilitates the removal and disassociation of the CD-ROM from the book, *Akiko* actually teaches away from “affixing the first optical bar code” and “affixing the first magnetic strip to the printed financial prospectus” as recited in amended Claim 1 and new Claim 21, respectively. Because *Akiko* clearly teaches away from these claims, the proposed *Boros-Akiko* combination must be withdrawn.

Second, the cited references fail to teach, suggest, or disclose “encoding the first portion of prospectus data as a first optical bar code...and affixing the first optical bar code to the printed financial prospectus” as recited in amended Claim 1. In rejecting Claim 1, the Examiner relies on *Boros* and *Akiko*. *Boros* discusses that electronic prospectuses may be distributed via the Internet or as CD-ROMs. (*Boros*; p. 9). In particular, *Boros* states:

Text-based electronic prospectuses are no longer novel. Multimedia prospectuses raise a new set of opportunities for communication with investors and corresponding regulatory challenges.

....Policy Statement 107...focuses on electronic prospectuses distributed via the Internet or other computer networks, CD-ROM and floppy disk.

(*Boros*; p. 9). Thus, *Boros* relates to using CD-ROMs or floppy disks to distribute electronic prospectuses. Notably, however, there is nothing in *Boros* that teaches, suggests, or discloses an “optical bar code” or “encoding the first portion of prospectus data as a first optical bar code” as recited in amended Claim 1. Merely distributing an electronic prospectus on a CD-ROM does not teach, suggest, or disclose “encoding the first portion of prospectus data as a first optical bar code...and affixing the first optical bar code to the printed financial prospectus” as recited in amended Claim 1.

Similarly, *Akiko* does not teach, suggest, or disclose the foregoing aspects of amended Claim 1. As explained above, *Akiko* relates to a “bag-shaped page” attached to a book. (Abstract). *Akiko* explains that the “bag-shaped page,” which is “bonded in a releasable manner,” may hold a CD-ROM. (Abstract). *Akiko* makes no mention of an “optical bar code” as recited in amended Claim 1. Merely attaching to a book a “bag-shaped page” that facilitates the removal of a CD-ROM does not teach, suggest, or disclose “encoding the first portion of prospectus data as a first optical bar code...and affixing the first optical bar code to the printed financial prospectus” as recited in amended Claim 1. Because the cited references fail to teach, suggest, or disclose these aspects of amended Claim 1, the cited references fail to support the rejection. For at least this reason, Applicant respectfully requests reconsideration and allowance of amended Claim 1.

Third, the cited references fail to teach, suggest, or disclose “storing the first portion of prospectus data in an electronically-readable format on a first magnetic strip...and affixing the first magnetic strip to the printed financial prospectus” as recited in new Claim 21. As shown above, *Akiko* relates to attaching a “bag-shaped page” to a book and *Boros* discuss using CD-ROMs or floppy disks to distribute electronic prospectuses. Neither *Akiko* nor *Boros* teach, suggest, or disclose a “magnetic strip” or “storing the first portion of prospectus data in an electronically-readable format on a first magnetic strip” as recited in new Claim 21. In addition, the cited references fail to teach, suggest, or disclose “affixing the first magnetic strip to the printed financial prospectus” as recited in new Claim 21. Because the cited references fail to teach, suggest, or disclose these aspects of new Claim 21, Applicant respectfully requests that the Examiner enter and allow new Claim 21.

Fourth, the cited references fail to teach, suggest, or disclose “storing the first portion of prospectus data in a first computer chip, wherein the first computer chip is readable by a smart card scanner...and affixing the first computer chip to the printed financial

prospectus” as recited in new Claim 24. In rejecting the claims, the Office Action states: “The examiner has interpreted an embedded computer chip to be a CD-ROM.” (Office Action; p. 2). The Examiner provides no explanation for this unreasonable interpretation of the claims. *Akiko* illustrates a CD-ROM as a standard compact disc that may be inserted into a CD drive. (*Akiko*; Fig. 1). Such a compact disc is not a “computer chip” as recited in new Claim 24. There is nothing in either *Boros* or *Akiko* that teaches, suggests, or discloses that a “computer chip” is a CD-ROM. “During patent examination, the pending claims must be given their broadest **reasonable** interpretation consistent with the specification.” MPEP § 2111 (emphasis added). “The broadest reasonable interpretation of the claims must...be consistent with the interpretation that those skilled in the art would reach.” MPEP § 2111 (citing *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)). It is simply unreasonable to assert that a CD-ROM is a “computer chip” as recited in new Claim 24. Furthermore, there is nothing in *Boros* or *Akiko* that teaches, suggests, or discloses that the “computer chip is readable by a smart card scanner” as recited in new Claim 24. Because the cited references fail to teach, suggest, or disclose these aspects of new Claim 24, Applicant respectfully requests that new Claim 24 be entered and allowed.

In rejecting Claims 8 and 14, the Examiner employs the same rationale used with respect to Claim 1. Accordingly, for at least the reasons stated above with respect to amended Claim 1, Applicant respectfully requests reconsideration and allowance of amended Claims 8 and 14.

Claims 2-7, 9-13, 15-20, 22-23, and 25-26

Claims 2-7, 9-13, 15-20, 22-23, and 25-26 depend from independent claims shown above to be allowable. In addition, these claims recite further elements not taught, suggested, or disclosed by the cited references. While deemed unnecessary to argue these additional points at this time, given the arguments presented above, Applicant reserves the right to present such argument, including the interpretation of any terms of the claims, should it become necessary or desirable to do so.

CONCLUSION

For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

The Examiner is invited to contact the Applicant's undersigned representative at 212-829-5407 to expedite prosecution.

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Date

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